

04/12/02 FRI 15:15 FAX 973 235 2363

PATENT LAW

006

#24

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, Washington, D.C. 20231.

John P. Parise  
(Print Name)

Date: August 9, 2001

(Signature)

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Brockhaus, et al.

Group: 1644

Serial No. 08/444,791, filed May 19, 1995

Examiner: R. Schwadron

For: HUMAN TNF RECEPTOR

RESPONSE TO OFFICE ACTION AND INFORMATION DISCLOSURE STATEMENT

Nutley, New Jersey 07110  
August 9, 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This Response is filed in response to the June 1, 2001 Office Action issued in connection with the above-identified patent application. A response to this Office Action was originally due July 1, 2001. A two-month extension of time is being requested concurrently. Accordingly, a response to this Office Action is now due September 1, 2001.

Serial No. 08/444,791

Filed: May 19, 1995

Claims 66-99 are pending in the subject application and are subject to an election of species requirement. Election was required under 35 U.S.C. § 121 for applicants to elect a single disclosed species. Applicants maintain that such requirement is improper and traverse this requirement. However, solely for examination purposes, applicants elect the species comprising DNA encoding 55 kD TNFBP (including claims 79-83 and 95-99) and DNA encoding IgG3 (including claims 72-73, 77-78, 82-83, 88-89, 93-94, and 98-99). Claims 66-70, 72-73, 79-80, 82-83, 84-86, 88-89, 95-96, and 98-99 read on the elected species. All of these claims are entitled to complete consideration on the merits.

Applicants traverse the election requirement because (i) the Patent Office is required as a matter of law to examine on the merits the entirety of the generic claims (see below) and (ii) it is late issued (over ten years have transpired since applicants first filed their priority application in the United States), the Patent Office has searched and issued an Office Action addressing the claimed species.

Procedures for making an election of species are described in MPEP 809.02 and 37 C.F.R. §1.146. Under 37 C.F.R. §1.146, the Patent Office may "require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is

Serial No. 08/444,791

Filed: May 19, 1995

found allowable" (emphasis added). Once a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed. MPEP 809.02(e). Therefore, the Patent Office should not have required election under 35 U.S.C. § 121 until a determination of patentability was made with respect to the generic claims.

Whether the claimed species are patentably distinct is irrelevant to the determination of patentability of applicants' claims directed to the elected species and the generic claims that read on these species. Unless all generic claims have been rejected, no question of patentability arises with regard to the non-elected species. In view of the limited number of species claimed in the present application, examination of each and every species on the merits should follow allowance of the generic claims.

*In re Wolfrum and Gold*, 179 USPQ 620, 622 (CCPA 1973) addresses the examination of claims in the context of rejection made under 35 U.S.C. § 112,

"the scope of the subject matter is governed not by the examiner's conception of the 'invention' but by that 'which the applicant regards as his invention'.... applicant is free under that provision to set the metes and bounds of 'his invention' as he sees them..... Thus a determination by the Patent Office that earlier, separate

Serial No. 08/444,791

Filed: May 19, 1995

claims encompass a 'plurality of different inventions' cannot serve, *under* § 112, as the basis for a rejection of a later combined claim....the rationale of the rejection also encompasses the provisions and mandate of 35 U.S.C. 101 and 121 (emphasis in original text)."

Applicants are entitled to a complete action on the merits of all claims, including those readable on the elected species, i.e. claims 66-70, 72-73, 79-80, 82-83, 84-86, 88-89, 95-96, and 98-99. Failure of the Patent Office to consider such claims in their entirety would be tantamount to a rejection and appealable. *In re Hass*, 179 USPQ 623, 627 (CCPA 1973) the court stated that

"An examiner's adverse action of this nature *is* a rejection, a denial of substantive rights. Review thereof must fall within the jurisdiction of the board" (emphasis in original text).

It is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978) at pages 331-332,

"§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text).

Applicants have the right to claim their invention as they deem appropriate, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold* at 622.

Serial No. 08/444,791  
Filed: May 19, 1995

The election requirement is late issued. Over ten years have passed since the first United States priority application was filed in 1990. The present application has been pending since May 19, 1995 and the Patent Office has searched and issued an Office Action addressing the claimed species on February 12, 1996. No substantive examination of the present application by the Patent Office in over five years, despite numerous Status Inquiries being filed by applicants (March 27, 1997, October 15, 1998, April 14, 1999, November 2, 1999, May 11, 2000, November 10, 2000). In fact, the present Office Action was not received by applicants until July 17, 2001 only after a telephone inquiry to the Patent Office revealed that the Office Action allegedly sent on June 1, 2001 was not received by applicants. To require an election at this point in time after the entire subject matter claimed in the application has been searched and examined would be prejudicial to applicants.

Applicants look forward to having all claims considered on the merits.

Pursuant to 37 C.F.R. §§ 1.56, 1.97 and 1.98, applicants respectfully direct the Examiner's attention to the document listed on enclosed Form PTO-1449.

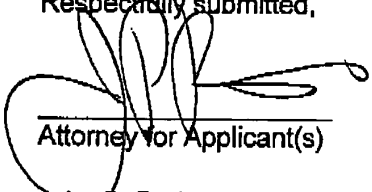
Serial No. 08/444,791  
Filed: May 19, 1995

Document C29 is listed on Form PTO-1449 and a copy is enclosed. This document was cited by the European Patent Office on April 10, 2001 in connection with a related patent application. Consideration of this document requested.

Since the Information Disclosure Statement is submitted after the first Office Action on the merits and after three months of the filing date for the captioned application, there is enclosed a Fee Sheet.

No fee, other than the fee for a two-month extension of time and the fee for consideration of the Information Disclosure Statement, is required in connection with the filing of this Response. If any fee is required in connection with the filing of this Response, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



\_\_\_\_\_  
Attorney for Applicant(s)

John P. Parise  
(Reg. No. 34,403)  
340 Kingsland Street  
Nutley, New Jersey 07110  
(201) 235-6326

Enclosures  
112225